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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/707,230

11/28/2003

Saul Katz

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EXAMINER

PRATT, HELEN F

ART UNIT

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1794

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/707,230	<b>Applicant(s)</b> KATZ ET AL.	
	<b>Examiner</b> Helen F. Pratt	<b>Art Unit</b> 1794	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 30 January 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1 and 8-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 8-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 10, 11, 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wilbert (5,776,887) in view of Tada et al. (JP 02002204662 A) and (Wikipedia (evidentiary reference) taken alone or Wilbert in view of Tada, and “all bran breakfast cereal (Applicants Glycemic index Food list).

Wilbert et al. disclose a composition containing the claimed ingredients as in claims 1, 10, 11 and 15. The carbohydrate content is seen to have been more than 50% as in claims 1, 10 and 11 because rolled oats, which are a complex carbohydrate with a low GI is used in predominant amounts and the reference discloses 62% carbohydrates (col. 8, lines 40-60.). Also, the GI is seen to have been within the claimed amounts of 1, 10, 11 and 15, due to the use of complex carbohydrates absent a showing to the contrary.

Claim 1 has been amended to require a lower glycemic index of the food item. However, Tada et al. disclose a composition containing bean curd refuse (a high fiber product) and devil's tongue jelly which is known to be a low glycemic product since it is

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high in fiber (Wikipedia encyclopedia). The devil's tongue is a carbohydrate, but is a complex carbohydrate, which does not raise the glycemic index. The mixture is seen to also contain fat and protein. Books are available which show the glycemic index of foods. Nothing new is seen in picking foods for their known function of taste and low glycemic index from a list of foods, since the concept of low glycemic foods are well known. "All bran" certainly meets the limitations of claim 1 and has a low glycemic Index (GI of 30). Therefore, it would have been obvious to use known ingredients, and known amounts of COH and a GI absent a showing to the contrary and to pick various ingredients which have a low glycemic index to make a low glycemic product.

Claims 1, 8, 10, 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sunvoid (6,458,378) Tada et al. (JP 02002204662 A) and (Wikipedia (evidentiary reference) taken alone or in Wilbert in view of Tada.

Sunvoid disclose a composition as in claim 1 for improving glucose metabolism in animals by controlling the insulin response, which contains a source of protein, fat, and carbohydrates (abstract). The carbohydrates in the food item are greater than 45% by weight. Grains are not considered to be rapidly absorbed carbohydrates, since they contain a lot of fiber, which keeps the carbohydrates from being rapidly absorbed (col. 8, lines 35-60). Claims 1 and 8, 10, 11 differ from the reference in the particular glycemic index (GI). Sunvoid discloses the use of a composition containing grains, which is seen to have produced a composition with a GI lower than 50 since grains are used in the composition and no simple sugars or sucrose.

Claim 1 has been amended to require a lower glycemic index of the food item. However, Tada et al. disclose a composition containing bean curd refuse (a high fiber product) and devil's tongue jelly which is known to be a low glycemic product since it is high in fiber (Wikipedia encyclopedia). The devil's tongue is a carbohydrate, but is a complex carbohydrate, which does not raise the glycemic index as it is basically not digestible. The mixture is seen to also contain fat and protein. Books are available which show the glycemic index of foods. Nothing new is seen in picking foods for their known function of taste and low glycemic index from a list of foods, since the concept of low glycemic foods is well known. Therefore, it would have been obvious to make a composition using the claimed ingredients, which have low glycemic indexes.

Claims 9 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sunvoid as applied to the above claims, and further in view of Wilbert (6,458,378).

Claim 9 further requires that the composition contains inulin, but not a starch. However, Wilbert discloses that it is known to use inulin in a diet, which controls the GI (col. 3, lines 50-59). Therefore, it would have been obvious to use a known source of fiber in the composition of Sunvoid for its known function.

Claims 1, 10, 11, 13, 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nidetch (\* Weight Watchers), pages 218, 219, Cheddar Muffins, Tada et al. (JP 02002204662 A) and (Wikipedia (evidentiary reference) taken alone or in Wilbert in view of Tada.

Nidetch disclose a composition containing protein, fat and carbohydrates where the total carbohydrate content is more than 45% as in claims 1 and 10. Casein is the major protein found in cheddar cheese and skim milk as in claim 14. The claims differ from the reference as to the particular GI. However, the GI is seen to have been less than 40 as in claims 1, 10, 11 and 14 and less than 35, as in claim 13 since the composition has been shown (pages 218, 219).

Claim 1 has been amended to require a lower glycemic index of the food item. However, Tada et al. disclose a composition containing bean curd refuse (a high fiber product) and devil's tongue jelly which is known to be a low glycemic product since it is high in fiber (Wikipedia encyclopedia). The devil's tongue is a carbohydrate, but is a complex carbohydrate, which does not raise the glycemic index. The mixture is seen to also contain fat and protein. Books are available which show the glycemic index of foods. Nothing new is seen in picking foods for their known function of taste and low glycemic index from a list of foods, since the concept of low glycemic foods are well known. Therefore, it would have been obvious to make a composition containing the claimed ingredients and glycemic index.

Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sunvoid in view of Wilbert, and further in view of Foster-Power International Table of Glycemic Index.

Claim 15 further requires that the composition is a food item with particular amounts of ingredients. However, it is seen that it would have been within the skill of the ordinary worker to determine the amounts of carbohydrate and the glycemic index of

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various foods and to make a composition with known ingredients which was within the claimed limitations especially as applicants have provided in their Information Disclosure Statement a table of Foods which shows the glycemic index of various foods. Attention is invited to *In re Levin*, 84 USPQ 232 and the cases cited therein, which are considered in point in the fact situation of the instant case, and wherein the Court stated on page 234 as follows:

This court has taken the position that new recipes or formulas for cooking food which involve the addition or elimination of common ingredients, or for treating them in ways which differ from the former practice, do not amount to invention, merely because it is not disclosed that, in the constantly developing art of preparing food, no one else ever did the particular thing upon which the applicant asserts his right to a patent. In all such cases, there is nothing patentable unless the applicant by a proper showing further establishes a coaction or cooperative relationship between the selected ingredients, which produces a new, unexpected, and useful function. *In re Benjamin D. White*, 17 C.C.P.A. (Patents) 956, 39 F.2d 974, 5 USPQ 267; *In re Mason et al.*, 33 C.C.P.A. (Patents) 1144, 156 F.2d 189, 70 USPQ 221. Also, Painter discloses the value of using the GI to determine which foods would have been desirable for people and that "an energy bar could be designed with COH's that provide a low glycemic response using fructose and that the GI can be accurately estimated from food (page 04, 1<sup>st</sup> col. 2<sup>nd</sup> paragraph, page 07, first para., col. 2.). Therefore, it would have been obvious to choose various foods with known amounts of carbohydrate and a known glycemic index in which to make a food composition.

## ARGUMENTS

Applicant's arguments filed 1-30-08 have been fully considered but they are not persuasive. Applicants argue that the Declaration from Mr. Saul Katz distinguishes the claimed compositions from the prior art. It is noted that the ingredients of the compositions of the previous rejections do not meet the claim limitations as now amended. However, as above, nothing new is seen in picking and choosing ingredients which have a low glycemic index, and a high carbohydrate content, since both these items are well known. In fact "all bran breakfast cereal " certainly meets the limitations of claim 1 and has a low glycemic Index (GI of 30, Applicants' Glycemic index Food list). Applicants recently submitted a reference to Jenkins et al. disclose that the "carbohydrate exchange lists that have regulated the diets of many diabetics for over three decades may not reflect the physiological effects of foods" (page 362, 1<sup>st</sup> col. ). Hence the testing of many foods to determine the glycemic index, or the real effect that carbohydrates were having in raising the blood glucose levels.

Applicants argue that the GI measurement of a mixed food will vary significantly based upon the type. However, applicants' claim 1 is to very broad categories of food of which there is 45% carbohydrate and the food item has a GI of 35 and no specific foods are listed.

Applicants argue that the combined references do not disclose any level of glycemic index testing. However, as applicants new references disclose, this work has been done by Jenkins et al. in particularly.



The rejection is maintained with the addition of additional references that show other low glycemic foods. Nothing new is seen in picking and choosing ingredients with a low glycemic index and a particular amount of carbohydrate, since it is known that various low GI foods exist and that it is healthful to eat foods with a lower GI index.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Helen F. Pratt whose telephone number is 571-272-1404. The examiner can normally be reached on Monday to Friday from 9:30 to 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Milton Cano, can be reached on 571-272-1398. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Helen F. Pratt/

Primary Examiner, Art Unit 1794

Hp 2-25-08

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